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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/930,668
Filing Date: August 15, 2001
Appellant(s): STARKEY ET AL.

Brian Clise, Reg. No. 47,497
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/8/09 appealing from the Office action

mailed 4/8/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0107849   HICKEY et al   08-2002

US-4,491,725   PRITCHARD   01-1985

US-4,975,840   DE TORE et al.   12-1990

* "IndiCare" Website Users Manual, 1997, pp. 1-17.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to another statutory class (such as a particular machine or apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. 63, 70 (1972); *Cochrane v. Deener,* 94 U.S.

780,787-88 (1876). If neither of these requirements is met by the claim, the method

is not a patent eligible process under §101 and should be rejected as being directed

to nonstatutory subject matter.

It is noted that the claims were amended to recite the method is "computer-

implemented" in the preamble.   However, there are two corollaries to the machine-

or-transformation test. First, a mere field-of-use limitation is generally insufficient to

render an otherwise ineligible method claim patent- eligible. This means the machine

or transformation must impose meaningful limits on the method claim's scope to

pass the test. Second, insignificant extra-solution activity will not transform an

unpatentable principle into a patentable process. This means reciting a specific

machine or a particular transformation of a specific article in an insignificant step,

such a data gathering or outputting, is not sufficient to pass the test.

Exemplary claims 1, 17, and 22 fail to provide the required tie to a machine or

apparatus in the body of the claims. The respective dependent claims fail to correct

the shortcomings of the present claims, and therefore are also rejected.

As such, claims dependent claims 2-16, 18-21, and 23-30 contain similar

deficiencies and fail to correct the deficiencies of claim 1, 17, and 22 respectively, and

are therefore also rejected.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-6, 9-12, are rejected under 35 U.S.C. 103(a) as being unpatentable

over "Indicare™- On-line Patient Assistance Program Website Users Manual." (referred

to hereinafter as Indicare) in view of Pritchard (US 4,491,725) and in further view of

Hickey (USUS 2002/0107849A1)

[claim 1]   Indicare discloses a method for identifying and applying for benefits for a

patient comprising:

- obtaining initial patient information (i.e. application/enrollment forms (page 3,

  7-10; 15-16).

- based upon initial patient information, making an initial determination as to

  whether it is likely that the benefits can be obtained (pg. 12, step 7)

- if the initial determination is that benefits are likely to be obtained, obtaining

  additional patient information, (page 13, 17—indicates whether

  pharmaceutical company is likely to decline/ require additional information;

  see also page 13—software checks to see in forms properly filled out)

Indicare discloses receiving patient information for a benefit program, but does

not expressly disclose the steps of receiving a referral from a medical facility for a

patient" and rejecting the referral if the initial determination is that it is unlikely that

benefits will be obtained.

Pritchard discloses a method further comprising receiving a referral from a

medical facility for a patient and rejecting the referral if the initial determination is that it

is unlikely that benefits will be obtained. (col. 4, lines 30-42; 65-col. 5, line 3; col. 7, lines 7-36—likely or unlikely to receive benefits). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Indicare with the teaching of Pritchard to provide an indication of whether or not benefits will be received. As suggested by Pritchard, one would have been motivated to include these features to minimize the hardship to patients by reducing the likelihood that they will have to pay full service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

Claim 1 has been amended to further recite:

"if the second determination is that it is likely that benefits can be obtained, then receiving additional information for the patient to complete an application the assistance program and at least one of submitting the completed application to the assistance program and providing a copy of the completed application for submission to the assistance program."

Indicare and Pritchard disclose the limitations of claim 1, as explained above but do not expressly disclose "if the second determination is that it is likely that benefits can be obtained, then receiving additional information for the patient to complete an application the assistance program and at least one of submitting the completed application to the assistance program and providing a copy of the completed application for submission to the assistance program."

However, it is well-known in the art to applicants or potential beneficiaries provide additional information as they become more likely to receive the desired benefit. For

example Hickey discloses a method wherein a user provides initial information, and if a

determination is that it is likely that benefits can be obtained, then receiving additional

information for the user to complete an application the assistance program and at least

one of submitting the completed application to the assistance program and providing a

copy of the completed application for submission to the assistance program. (Figure 5,

par. 55). Hickey reference discloses gathering additional information and submitting

completed application information to an assistance program (e.g. scholarship search).

(Figure 5; par. 55)   At the time of the applicant's invention, it would have been obvious

to one of ordinary skill in the art to modify the method of Indicare and Pritchard in

combination with the teaching of Hickey, to have the user to provide additional

information and a completed application, upon determining that the user/applicant is

(more) likely to receive the benefit. As suggested by Hickey, one would have been

motivated to include this feature to help the applicant find assistance without having to

present him/her with an excessive number of questions upfront (par. 55)

[claims 2-6]   Indicare gathers information regarding the patient's age and medical

condition; income and financial resources. (page 15, Questionnaire) The patient

information is compared to well-established criteria (e.g. agency criteria) (page 17—

Pharmaceutical company programs)

[claims 9-10]   Indicare discloses a system/ method wherein additional patient

information includes a discharge diagnosis (page 17-questionnaire). Indicare further

discloses providing prompts to assist in the completion of an application (page 12

"patient data" and "physician data" section on screen shots)

[claim 11] Indicare discloses determining whether the patient is covered by an

assistance program. (page 17 questionnaire —asks patient if they have health

insurance)

[claim 12] Indicare discloses determining whether the patient is previously in the

system with a claim/application for assistance. (page 13—allows users to start with old

claim/application information.

4.   Claims 13, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over "Indicare™- On-line Patient Assistance Program Website Users Manual." (referred

to hereinafter as Indicare) in view of Pritchard (US 4,491,725).

[claim 13] Indicare discloses a method for accepting a referral for a patient, comprising

the steps of:

-   receiving a patient referral, the patient referral including initial patient

    information, (physician letters requesting assistance from the pharmaceutical

    company (i.e. donator) on behalf of the patient. (pages 3,5-6)

- determining whether to accept the patient referral by:

    o comparing the initial patient information to a well-established criteria
       associated with an assistance program; (pg. 12, step 7)

    o if the comparison indicates that the initial patient information satisfies the
       well-established criteria, then accepting the patient referral; (page17—
       indicates whether pharmaceutical company is likely to decline/ require
       additional information.)

    o if the patient referral is accepted, then obtaining additional patient
       information; (pages 13, 17—indicates whether pharmaceutical company
       is likely to decline/ require additional information.)

Claim 13 has been amended to further recite the assistance program is for

"Medicaid" and

    o comparing the initial patient information and the additional patient
       information to eligibility requirements for the assistance program; and
       (page 13, 17)

    o if the comparison indicates it is likely that benefits can be obtained under
       the assistance program, then providing an application for the assistance
       program. (pages 13, 14-15,17—i.e. acceptance or denial of a claim)

Indicare discloses receiving patient information for a benefit assistance program, but

does not expressly disclose comparing information and eligibility requirements for

the Medicare Program.

Pritchard discloses a method further performing comparisons and assessing benefit

eligibility for Medicare and Medicaid. (col. 4, lines 30-42; 65-col. 5, line 3; col. 7, lines

7-63). Pritchard also discloses that application/claim forms are provided to claim the

benefits. (col. 7, lines 37-50) At the time of the applicant's invention, it would have

been obvious to one of ordinary skill in the art to modify the method of Indicare with

the teaching of Pritchard to provide an indication of whether or not Medicare benefits

will be received. As suggested by Pritchard, one would have been motivated to

include these features to minimize the hardship to patients (e.g. low income and

elderly patients) by reducing the likelihood that they will have to pay full service fees,

while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

[claim 17]   Indicare further discloses providing prompts to assist in the completion of

an application (page 12 "patient data" and "physician data" section on screen shots)

[claim 18]   Indicare discloses automatically completing a section of the application

using the initial patient information. (pages 13-14)

[claims 19-21] Indicare discloses a method wherein the patient referral is received and

accepted by a pharmaceutical company (i.e. an entity independent of the medical

provider providing patient treatment)(page 17). Indicare further discloses that medical

providers still cover some of the cost to accepted participants (page 3, last paragraph).

Indicare further discloses submitting and monitoring the application to the assistance

program (page 14-15,17—i.e. acceptance or denial of a claim)

5.   Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

"Indicare™- On-line Patient Assistance Program Website Users Manual" ,Pritchard, and

Hickey (USUS 2002/0107849A1) in view of DeTore et al (USPN 4,975,840).

[claims 7-8]   Indicare discloses the method/system of claim 1 as explained in the

rejection of claim 1, but does not expressly disclose examining probability models.

However, DeTore discloses that it is well known in the insurance arts to examine

probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-

32) At the time of the applicant's invention, it would have been obvious to one of

ordinary skill in the art to modify the system and method of Indicare with the teaching

DeTore to compare patient information to probability models. As suggested by DeTore,

one would have been motivated to include this feature to assist the program in avoiding

excessive financial losses (col. 18, lines 23-63)

6.   Claims 14-16, and 22- 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over "Indicare™- On-line Patient Assistance Program Website Users

Manual" and Pritchard in view of DeTore et al (USPN 4,975,840).

[claims 14-16] Indicare discloses the method/system of claim 13 as explained in the

rejection of claim 13, but does not expressly disclose examining probability models.

However, DeTore discloses that it is well known in the insurance arts to examine

probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-

32) At the time of the applicant's invention, it would have been obvious to one of

ordinary skill in the art to modify the system and method of Indicare with the teaching

DeTore to compare patient information to probability models. As suggested by DeTore,

one would have been motivated to include this feature to assist the program in avoiding

excessive financial losses (col. 18, lines 23-63)

[claim 22,26]   Indicare discloses a method for identifying and applying for benefits

for a patient comprising the steps of :

- obtaining initial patient information (i.e. application/enrollment forms (page 3,

    7-10; 15-16).

- based upon initial patient information, making an initial determination as to

    whether it is likely that the benefits can be obtained (pg. 12, step 7) by

    comparing initial patient information to well-established criteria (page 17—

    Pharmaceutical company programs)

- if the initial determination is that benefits are likely to be obtained, obtaining

    additional patient information, (pages 13, 17—indicates whether

    pharmaceutical company is likely to decline/ require additional information.)

- providing a second indication that benefits are likely and selecting the

    identified the assistance program (pages 13, 14-15,17—i.e. acceptance or

    denial of a claim)

Claim 22 has been amended to recite "making a subsequent determination as to

whether it is likely that benefits can be obtained for the patient by comparing the initial

patient information and the additional patient information to the first and second

assistance program[s] that [are] identified." Indicare discloses the features of claim as

explained above, but does not expressly disclose making a subsequent determination

as to whether it is likely that benefits can be obtained for the patient by comparing the

initial patient information and the additional patient information to the first and second

assistance program[s] that [are] identified.

Pritchard discloses a method further comprising making a subsequent

determination as to whether it is likely that benefits can be obtained for the patient by

comparing the initial patient information and the additional patient information to the first

and second assistance program[s] that [are] identified. (col. 5, lines 40-65; col. 7, line 7-

37; col. 8, lines 30-43—reviews secondary and tertiary insurance coverage

qualifications, Medicare/Medicaid qualifications.) At the time of the applicant's

invention, it would have been obvious to one of ordinary skill in the art to modify the

method of Indicare with the teaching of Pritchard to provide an indication of whether or

not benefits will be received.   As suggested by Pritchard, one would have been

motivated to include these features to minimize the hardship to patients (e.g. low

income and elderly patients) by reducing the likelihood that they will have to pay full

service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

Indicare discloses the method/system of claim 22 as explained above, but does

not expressly disclose examining probability models. However, DeTore discloses that it

is well known in the insurance arts to examine probability models for policy (e.g.

assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's

invention, it would have been obvious to one of ordinary skill in the art to modify the

system and method of Indicare and Pritchard in combination with the teaching DeTore

to compare patient information to probability models. As suggested by DeTore, one

would have been motivated to include this feature to assist the program in avoiding

excessive financial losses (col. 18, lines 23-63)

[claim 23] Indicare further discloses providing prompts to assist in the completion of an

application (page 12 "patient data" and "physician data" section on screen shots)

[claims 24-25]   Indicare gathers information regarding the patient's age and medical

condition; income and financial resources. (page 15, Questionnaire). The patient

information is compared to well-established criteria (e.g. agency criteria) (page 17—

Pharmaceutical company programs)

[claim 27-28]   Indicare and Pritchard disclose the method/system of claim 22, but do

not expressly disclose examining probability models. However, DeTore discloses that it

is well known in the insurance arts to examine probability models for policy (e.g.

assistance programs) acceptance. DeTore further discloses that the probability models

used are based upon prior experience in obtaining similar coverage (i.e. benefits under

the second assistance program) (col. 18, lines 23-32) At the time of the applicant's

invention, it would have been obvious to one of ordinary skill in the art to modify the

system and method of Indicare with the teaching DeTore to compare patient information

to probability models. As suggested by DeTore, one would have been motivated to

include this feature to assist the program in avoiding excessive financial losses (col. 18,

lines 23-63)

7.   Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

"Indicare™- On-line Patient Assistance Program Website Users Manual," and

Pritchard, and in further view of Admitted Prior Art (in accordance with MPEP 2144.03)

[claims 29-30]   Indicare and Pritchard disclose the method of claim 13 as explained

in the rejection of claim 13, but do not expressly disclose that the Medicaid assistance

program is for disability or includes analysis of indigence status. However, it is well

known that indigence/income and disability are eligibility criteria for Medicaid. At the

time of the applicant's invention, it would have been obvious to one of ordinary skill in

the art to review the elements for applicant. One would have been motivated to include

this feature to comply with state and federal standards and regulations.

Applicant has failed to traverse the use of Official Notice in rejection of these

claims in the Final Rejection mailed 12/12/07. As such, the noted facts are now

considered admitted prior art in accordance with MPEP 2144.03.

(10) Response to Argument

(A)   Appellant argues that claims 1, 17, and 22 meet the requirements of 35 USC

101.

In response, as explained in the rejection above, process claims §101 process

must (1) be tied to a machine or apparatus or (2) transform underlying subject matter

(such as an article or materials) to a different state or thing. *Diamond v. Diehr,* 450 U.S.

175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,*

409 U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876). If neither of

these requirements is met by the claim, the method is not a patent eligible process

under §101 and should be rejected as being directed to nonstatutory subject matter.

As further explained, mere field-of-use limitation (i.e. a preamble recitation) is

insufficient to render an otherwise ineligible method claim patent-eligible.

Furthermore, insignificant extra-solution activity will not transform an unpatentable

principle into a patentable process: "[T]he involvement of the machine or

transformation in the claimed process must not merely be insignificant extra-solution

activity." *In re Bilski,* 88 USPQ2d 1385, 1396 (Fed. Cir. 2008)   Reciting a specific

machine or a particular transformation of a specific article in an insignificant step,

such a data gathering or outputting, is not sufficient to pass the test.

In the instant case, the applicant has Applicant previously amended rejected

claims 1,17, and 22 to recite "computer-implemented" in the preamble of the claim. The

recitation of an apparatus or machine only in the preamble is nominal/field of use

recitation, and does not clarify the involvement or use of an apparatus.

(B)   On page 10, the Appellant argues that the addition of the phrase "computer-

implemented" is sufficient to overcome the 101 rejection of claims 1,17, and 22.

As explained in the 101 rejection, mere field-of-use limitations (i.e. a preamble

recitation) are insufficient to render an otherwise ineligible method claim patent-

eligible.   Moreover, appellant's arguments regarding the addition of the phrase

"computer-implemented" underscore the fact that the amended phase does not

clarify the involvement or use of an apparatus. (e.g. computer).

Appellant argues that claim 1 "requires the logic of steps 'based on [] initial

patient information, making an initial determination as to whether it is likely that benefits

can be obtained.' "   The appellant further states that "it is clear that claim 1 is hosted

on a computer capable of a logic-based comparison of the information from the patient

to one or more assistance programs to identify a 'likely' eligibility, and continues with a

further logic-based comparison, culminating in a completed application."

The Examiner respectfully disagrees that it is clear that computer logic is

required or inherent in each of these steps. The instant claim(s) are method claims do

not expressly recite computer logic or a computer's use in any particular step.

Furthermore, Applicant's specification suggests that the "determinations" are not

always made using computer logic. Page 5, lines 11-16 of Applicant's specification,

states the following: "The assistance coordinator makes an initial determination as to

whether the patient is likely to qualify for an assistance program. If the initial

determination is that the patient is likely to qualify for an assistance program, then the

assistance coordinator accepts the referral from the hospital and attempts to obtain

assistance for the patient."

Also, on a related note, when the preamble recites "computer-implemented" in

the body without providing any further clarification in the claims, it raises issues

regarding how and when the apparatus/machine is involved in a particular method

steps. In other words, a potential infringer is not well-advised by the claim language as

to which steps require the apparatus/ machine and which do not. The "computer-

implementation" (or the use of the computer) is not clear from the current language of

claims 1, 17, and 22.

As such, the rejection of claims 1-30 under 35 USC 101, is proper and should be

maintained.

(C)   On page 12 of the Brief, Appellant argues that claims 1-30 qualify as statutory

because claims 1,17, and 22 transform input into an application for assistance.

In response, Appellant's the method performed in claims 1, 17, and 22 does not

transform claims do not qualify do not transform the underlying subject matter into a

different state or thing.   Page 28 of the Bilski decision clarifies, "Purported

transformations or manipulations simply of public or private legal obligations or

relationships, business risks, or other such abstractions cannot meet the test because

they are not physical objects or substances, and they are not representative of physical

objects or substances." In Bilski, the CAFC classified these "purported transformations or manipulations" as "ineligible transformations."

(D)   Appellant further argues on page 14 of the Brief, that Indicare, Pritchard and Hickey do not teach applicant's claimed invention. In particular, Appellant argues that Indicare does not disclose a stepwise determination of likelihood of receipt of benefits.

In response, the Examiner disagrees with the Appellant's interpretation of the prior art. It is further noted that the method claims rely extensively on broad and conditional claim language to attempt to define applicant's invention.

For example, the applicant argues that Indicare reference "makes no analysis and no determination other than whether the drug is listed in the database for reimbursement." (page 14 of Appeal Brief) However, Indicare discloses providing free drugs to indigent patients and the indigent patient claims process. (pages 14-16) The prior art also does determines whether a drug qualifies for reimbursement. (page 10-12 of Indicare). This determination step meets the claim limitation "based upon initial patient information, making an initial determination as to whether it is likely that benefits can be obtained for the patient under an assistance program. "

In the process disclosed by Indicare, some level of patient information is provided (e.g. Patient questionnaire, page. 15; drug needed by the patient; physician used by the patient; page 8; patient name , page 7). A determination is made regarding whether the forms are filled out properly, (page 12, step 7); whether additional forms will be required based upon the drug name/ drug type (page 17) and the user is

given feedback regarding whether the benefit forms have been appropriately filled out

(page 13). Based upon the patient information (e.g. whether the drug qualifies, whether

the patient qualifies as indigent), certain individuals may qualify for the benefit (e.g. drug

reimbursement), while others may be denied.

On the other hand, while the appellant argues the merits of the instant invention,

the current claim language recites no parameters to further define the Applicant's

invention over the "determination process" of the prior art.   First of all, applicant relies

upon relative terms such as "likely" and "unlikely" that the benefits can be obtained.

There is no scale or measure providing a frame of reference for these terms.   The use

of the probable language in combination with applicant's reliance on conditional claim

language, it is not necessary that all steps in the method steps are carried out.   (e.g. if

A, then B based upon a determination that the receipt of benefits is "likely" or "unlikely")

Furthermore, applicant argues that there is no analysis in the Indicare reference.

However, the current claim language fails to recite any analysis or define what criteria

are required or weighed in making the critical "determination" steps

Finally, the Appellant suggests the applied references are not germane to

applicant's invention. However, the current claim language, particularly of claim 1, fails

to define what the obtained benefits are in Applicant's invention and how they

distinguish over the prior art. In other words, the receipt of free medication,

reimbursement for medical services provided, or acceptance into a program (e.g.

insurance program) may all reasonably be considered benefits.

(E)   Appellant argues against the Indicare reference stating that that "it does not

make sense to suggest that a 'determination' may be made based upon a person's

name."

In response to Applicant's argument a person's name would be used in the

"determination" process, nothing in the current claim language precludes this possibility.

As previously stated, the current claim language fails to outline details for what is

performed during the "determination" step(s) and does not recite what is "likely" to be

accepted or rejected. Furthermore, the claim does not recite what must be included in

the patient information.

Moreover, in instances if the individual is banned from receiving benefits (e.g.

prior fraudulent activity), and has their name on a list reflecting this, then provision of a

name is enough to perform a determination.

Applicant is arguing limitations which may have been intended, but which are not

recited in the current claim language. As such the Examiner has given the claims the

broadest reasonable interpretation and applied art accordingly.

(F)   Appellant argues that the prior art does not disclose a "computer-implemented

method for identifying applying for benefits" which includes the step of "at least one of

submitting the completed application to the assistance program and providing a copy of

the completed application for submission to the assistance program."

In response to applicant's arguments, the recitation "computer-implemented

method for identifying applying for benefits" has not been given patentable weight

because the recitation occurs in the preamble. A preamble is generally not accorded

any patentable weight where it merely recites the purpose of a process or the intended

use of a structure, and where the body of the claim does not depend on the preamble

for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v.*

Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It should also be noted

that Indicare discloses an computer-implemented method and system for applying for

benefits (i.e. free medication).

Furthermore, it is further noted that applicant's final step in the recited method is

listed in the alternative: "***at least one of*** submitting the completed application to the

assistance program and providing a copy of the completed application for submission to

the assistance program." Only one of these steps needs to be performed to address

the claim limitations.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). The Hickey reference was provided to disclose gathering additional information

and **submitting a completed application information to an assistance program**

(e.g. scholarship search). (Figure 5; par. 55) It was the combination of references

which was provided to address the claim language.

In response to applicant's argument that Hickey is nonanalogous art, it has been

held that a prior art reference must either be in the field of applicant's endeavor or, if

not, then be reasonably pertinent to the particular problem with which the applicant was

concerned, in order to be relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

Hickey at the very least is reasonably pertinent the particular problem. The Indicare

reference and the applicant's claimed invention both may request a user to provide

additional/supplementary information in order to complete application information to

participate in an assistance program and receive a benefit.

(G)   Regarding claim 13, Appellant argues that argues that Pritchard does not make a

determination of whether it is likely that benefits will be obtained.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

Applicant argues that the Pritchard reference is not in keeping with applicant's

invention, because the users of the Pritchard method already have Medicare. However,

payment or reimbursement for medical services provided, or acceptance into a program

which provides these services (e.g. insurance program), may all reasonably be

considered benefits. Pritchard discloses a method in which a determination is made

regarding whether the individual will or will not receive benefits (e.g. will individual receive coverage for medical services). In particular, Pritchard discloses a method further performing comparisons and assessing benefit eligibility for Medicare and Medicaid benefits (col. 4, lines 30-42; 65-col. 5, line 3; col. 7, lines 7-63). Pritchard also discloses that application/claim forms are provided to claim the benefits. (col. 7, lines 37-50)

Indicare discloses receiving patient information for a benefit assistance program, but does not expressly disclose comparing information and eligibility requirements for the Medicare Program.

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Indicare with the teaching of Pritchard to provide an indication of whether or not Medicare benefits will be received. As suggested by Pritchard, one would have been motivated to include these features to minimize the hardship to patients (e.g. low income and elderly patients) by reducing the likelihood that they will have to pay full service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

(H)   On pages 18-19, Appellant argues that DeTore has been improperly applied to reject applicant's invention.

In response, applicant states that the "assistance program" is not an insurance program. However, the current claim language does not clarify how the assistance program is distinct from other types of benefit programs. Again, applicant relies upon relative terms such as "likely" and "unlikely" that the benefits can be obtained. There is

no scale or measure providing a frame of reference for these terms.   The use of the

probable language in combination with applicant's reliance on conditional claim

language, it is not necessary that all steps in the method steps are carried out.   (e.g. if-

then, based upon a determination that the receipt of benefits is "likely" or "unlikely")

Furthermore, the current claim language fails to define what criteria are required

or weighed in making the critical "determination" steps.

Also, the Appellant suggests the applied references, particularly case DeTore,

are not relevant to applicant's invention. However, the current claim language fails to

define what the obtained benefits are in Applicant's invention and how they distinguish

over other benefit programs (e.g. in the prior art).   The receipt of free medication,

payment and reimbursement for medical services provided, or acceptance into a

program which provide any of these items (e.g. insurance program) may all reasonably

be considered benefits. Applicant's claim language has been given the broadest

reasonable interpretation and art applied accordingly.

The DeTore reference has been applied to disclose that probability models for it

is well known in the insurance arts to examine probability models for insurance policies

(e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the

applicant's invention, it would have been obvious to one of ordinary skill in the art to

modify the system and method of Indicare and Pritchard in combination with the

teaching DeTore to compare patient information to probability models. As suggested by

DeTore, one would have been motivated to include this feature to assist the program in

avoiding excessive financial losses (col. 18, lines 23-63)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R. L. P./

Examiner, Art Unit 3626

/C. Luke Gilligan/

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